

Atty Dkt No. PP01468.002  
Client Dkt No. 2300-1468  
PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

SHIRLEY et al.

Serial No.: 09/187,661

Group Art Unit: 1653

Filing Date: November 6, 1998

Examiner: F. Moezie

Title: NOVEL IGF-I COMPOSITION AND ITS USE

COMMUNICATION

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

A Petition to Grant Filing Date of November 6, 1998 was filed on January 5, 1999 which was denied. A Request for Reconsideration of Decision Dismissing Petition to Grant Filing Date was filed June 5, 2000, submitting additional documents to evidence that November 6, 1998 was the correct filing date. To date, a decision has not been received on the Request for Reconsideration.

This application has been allowed with an Issue Fee due February 20, 2002. Applicant does not wish to pay the Issue Fee until the filing date has been corrected. Therefore it is imperative that applicant obtain a decision on the Request for Reconsideration as soon as possible.

Respectfully submitted,

Date: 12/21/01

By: [Signature]  
Roberta L. Robins  
Registration No. 33,208

ROBINS & PASTERNAK LLP  
90 Middlefield Road, Suite 200  
Menlo Park, CA 94025  
Telephone: (650) 325-7812  
Fax: (650) 325-7823

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JAN 03 2002  
OFFICE OF PETITIONS

A. Assistant Commissioner For Patents  
Washington, DC 20231

Date Received: 06/05/2000  
Atty. Dkt. No. 5784-3

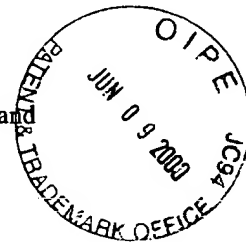
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OFFICE OF PETITIONS

Application No. 09/187,661; Filing Date November 6, 1998  
Inventor(s): Shirley et al.; Title of Invention: NOVEL IGF-1 COMPOSITION  
AND ITS USE

Documents Enclosed: Request For Reconsideration Of Decision Dismissing  
Petition To Grant Filing Date And To Refund Petition Fee with attachments 9-  
16.

Check Enclosed -----

Kindly acknowledge receipt by placing office stamp hereon and  
returning postcard to: LTH/Nora  
ALSTON & BIRD LLP



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Shirley *et al.*

Appl. No.: 09/187,661

Filed: November 6, 1998

For: NOVEL IGF-I COMPOSITION AND ITS USE

Group Art Unit: 1653

Examiner: Moezie, F.

June 5, 2000

RECEIVED  
JAN 03 2002  
OFFICE OF PETITIONS

REQUEST FOR RECONSIDERATION OF DECISION  
DISMISSING PETITION TO GRANT FILING  
DATE AND TO REFUND PETITION FEE

Assistant Commissioner for Patents  
ATTN: Special Program Law Office  
Washington, DC 20231

Sir:

In response to the Decision Dismissing Petition to Grant Filing Date and to Refund Petition Fee, Applicants hereby request reconsideration in view of the following evidence.

Applicants submit herewith additional documents as evidence of November 6, 1998 being the correct filing date under 37 C.F.R. §1.10:

9. A copy of the Patent Control Docket Sheet for Attorney Docket No. 5784-3 showing the application (assigned U.S. Serial No. 09/187,661) mailed to United States Patent and Trademark Office (PTO) on November 6, 1998;

10. A copy of the Patent Control Docket Sheet for Attorney Docket No. 5784-25 showing the application (assigned U.S. Serial No. 09/188,051) mailed to the PTO on November 6, 1998;

11. A copy of the printout for the Action Screen for the present application (Attorney Docket No. 5784-3), which was obtained from the Alston & Bird, LLP Patent Database showing the Action Type as "App Sent PTO" on 11/06/98;

12. A copy of the printout for the Action Screen from the Alston & Bird, LLP Patent Database for concurrently filed U.S. Application Serial No. 09/188,051 (Attorney Docket No. 5784-25) showing the Action Type as "App Sent PTO" on 11/06/98;

In re:

In re: Shirley *et al.*

Appl. No.: 09/187,661

Filing Date: November 6, 1998

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13. A copy of the face of the trifold for Attorney Docket No. 5784-3 showing the application as sent to the PTO on November 6, 1998;

14. A copy of the face of the trifold for Attorney Docket No. 5784-25 showing the application as sent to the PTO on November 6, 1998;

15. A copy of the relevant page from the Secretary's Log of PTO Mailings showing Utility Patent Applications for File Nos. 5784-3 and 5784-25 were transmitted to the PTO on November 6, 1998;

16. An Affidavit signed by Rebecca Allen, which states that she is the secretary who kept the Logbook cited in item 15 above, and that she entered the information regarding the date these two applications were transmitted to the PTO.

As previously noted in the Petition dated January 5, 1999, the present application and U.S. Serial No. 09/188,051 are related, and great care was taken to file these applications on the same day. The 09/188,051 application was granted the proper filing date of November 6, 1998, as indicated on the Official Filing Receipt and our return postcard for this application (items 3 and 4, respectfully, submitted with the original Petition). However, the present application was given a filing date of November 5, 1998, as shown by copies of the Official Filing Receipt and our return postcard for this application (items 5 and 6, respectfully, submitted with the original Petition).

Applicants submit herewith copies of the Patent Docket Control Sheets for Attorney Docket No. 5784-3 (U.S. Serial No. 09/187,661) and Attorney Docket No. 5784-25 (U.S. Serial No. 09/188,051) (items 9 and 10, respectively), both showing that the utility applications were mailed to the PTO on November 6, 1998. See highlighted section in Attachments 9 and 10 under "APPLICATION PREPARATION INFORMATION". Patent Docket Control sheets are maintained by the Patent Secretary as written confirmation of actions taken in an application. Care is taken to reflect the correct information. The entries are made as actions are taken.

Applicants also submit copies of the printouts of the Action Screens for these Attorney Docket Nos. (items 11 and 12, respectively) obtained from the Alston & Bird Patent Database. This Patent Database serves as a computerized docketing system that provides a history of all

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actions taken during prosecution of an application. Thus, the firm's docketing system tracks critical due dates and final dates of all actions received from the U.S. Patent and Trademark Office with respect to a particular application. In addition, non-due-date types of actions, such as the mailing of an application, assignment, declaration, and all communication letters, are also tracked.

When original documents are received from the PTO, they are entered into the Patent Database. The information once entered is distributed to attorneys by means of docket reports. The reports identify what action is due (i.e., U.S. Rejection) and whether it is a due date with extensions or a final date. When an action has been satisfied, the secretary submits the Patent Docket Control Sheet to the docketing department, and the due date or final date is then closed. Closing an action prevents it from appearing on future docket reports. Even though the action is closed it is retained as history. For non-due-date types of actions, such as the mailing of an application, the secretary notes the action on the Patent Docket Control Sheet and submits the sheet to the docketing department so that the action can be noted in the Patent Database. Just as for due-date types of actions, once a non-due-date action is entered into the history for the application, the action is closed.

The Patent Database is safeguarded by the use of Patent Docket Control Sheets and in the case of patents, the file's trifold. As further evidence, copies of the face of the trifold for U.S. Application Serial Nos. 09/187,661 and 09/188,051 showing the November 6, 1998 filing date are submitted herewith (items 13 and 14).

Alston & Bird has various levels of security placed on the Patent Database to prevent modification of history of actions taken on a particular application. Only authorized persons (docketing staff, a few individuals in the foreign department, the head of the Patent Solicitation Group at Alston & Bird's Intellectual Property Group, and the head paralegal for Patent Solicitation) have the ability to add, delete, or modify data. All others in the firm have only the ability to print, browse, and view the information in the Patent Database. They cannot alter the database in any way.

In re:

In re: Shirley *et al.*

Appl. No.: 09/187,661

Filing Date: November 6, 1998

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As further evidence of the November 6, 1998 filing date, Applicants submit herewith a copy of the Secretary's Log of PTO Mailings, showing that the Utility Applications for Attorney Docket Nos. 5784-3 and 5784-25 were mailed on this date (item 15). A signed Affidavit to this effect is concurrently submitted herewith (item 16).

There is no error on the part of Applicants. These two applications were intended to have the same filing date, and as such, Applicants concurrently filed them with the USPS on November 6, 1998. As the companion 09/188,051 application was granted the proper filing date as recorded by the Express Mail signature on the Utility Application Transmittal Cover Sheet, Applicants respectfully request the granting of November 6, 1998, as the filing date for the present application.

It is not believed that any further fee is required for consideration of this response. However, any additional fee may be charged or any overpayment credited to our Deposit Account No. 16-0605. Because no defect existed, however, Applicant also respectfully requests refund of the petition fee submitted with the original Petition filed January 5, 1999.

Respectfully submitted,



W. Murray Spruill  
Attorney for Applicant  
Registration No. 32,943

**ALSTON & BIRD LLP**

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Tel Raleigh Office (919) 420-2200

Fax Raleigh Office (919) 420-2260

RTA01/2078778v1

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner For Patents, ATTN: Special Program Law Office, Washington, DC 20231, on June 5, 2000.



Denise O. Funderburke

# PATENT DOCKET CONTROL SHEET

[illegible]

Provisional App. filed 11-7-  
Serial No: 60/064,891

035784-172864

035784-172864

[illegible]



Actions

Record 109176 on screen

Record found

A C T I O N S D U E

Client: 005784 Matter: 3 Country: US Sub Case:  
 Working Atty: WMS LTH WMS User: cin  
 APP SENT P 0057843US 0057843USAPP SENT PTO11/06/98

	Action	Due	Indicator
Action Type: APP SENT PTO PTO Date: 11/06/98	Due	Date	
Response Sent Dt: 11/06/98 Action Status Chk: 05/06/99 Completed: yes		/ / / / / / / / / /	

Remarks:

Report:

Today's Date: 06/01/00

Last Update: 12/03/98

F4CMDHELP ESCEXIT F2SAVE SH-F1TABLE F3VIEW F7DEL F8MODIFY F9QBE F10MULTI

Actions

Record found

Record 109179 on screen

A C T I O N S    D U E

Client: 005784 Matter: 25 Country: US Sub Case:  
 Working Atty: WMS LTH WMS User: cin  
 APP SENT P 00578425US 00578425USAPP SENT PTO11/06/98

	Action Due	Due Date	Indicator
Action Type: APP SENT PTO PTO Date: 11/06/98		/ /	
Response Sent Dt: 11/06/98 Action Status Chk: 05/06/99 Completed: yes		/ / / / / /	

Remarks:

Report:

Today's Date: 06/01/00

Last Update: 11/30/98

F4CMDHELP ESCEXIT F2SAVE SH-F1TABLE F3VIEW F7DEL F8MODIFY F9QBE F10MULTI

Attorney's Docket No. 5784-3

**PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Shirley *et al.*  
Appl. No.: 09/187,661                      Group Art Unit: 1653  
Mailed: November 6, 1998              Examiner: Moezie, F.  
For: NOVEL IGF-I COMPOSITION AND ITS USE

Assistant Commissioner for Patents  
Washington, DC 20231

**AFFIDAVIT OF SECRETARY'S LOG OF PTO MAILINGS**

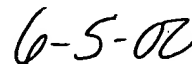
Sir:

I, Rebecca Allen, hereby certify that I am the individual who maintained the Secretary's Logbook of PTO Mailings from which the copy of the page submitted concurrently herewith was taken. While an employee of Alston & Bird, LLP, I maintained this logbook in accordance with firm policy to keep track of the date of mailing of all communications I was in charge of sending to the United States Patent and Trademark Office (PTO). Further, on November 6, 1998, I entered into my Secretary's Logbook of PTO Mailings the mailing date of November 6, 1998 for the Utility Patent Applications for Attorney Docket Nos. 5784-3 and 5784-25. I further certify that I am over the age of 21 and I am not a party or an attorney in this action.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Rebecca Allen  
RTA01/2078824v1



Date